

REMARKS/ARGUMENTS

Reconsideration of this application is requested. In this response, claim 1 has been amended. Claim 2 has been cancelled. Claims 13 to 48 have been appropriately re-numbered as claims 16-51. Consequently, claims 1, 3 to 51 are under consideration.

I Double Patenting

Claims 1,5,6,12,13-15,18,20-49 stand provisionally rejected on provisional obviousness-type double patenting grounds as being allegedly unpatentable over claims 5,6,10,11,13,14,18 and 23-51 of US Patent Application No. 10/760,256.

Claims 19-49 stand provisionally rejected on provisional obviousness-type double patenting grounds as allegedly unpatentable over claims 5,6,10,11,13,14,18 and 23-51 of US Patent Application No. 10/760,256.

A terminal disclaimer in compliance with 37 CFR 1.321 executed by the inventors accompanies this response to the Action. Accordingly it is believed that the nonstatutory double patenting rejection should be withdrawn. Such action is respectfully requested.

II Claim rejections 35 USC § 102

Claims 1,4,12,14,17,18,20,22,33,39,40-43,46,47,49 and 51 were rejected under 35 USC 102(b) as being clearly anticipated by Martin (US Patent No. 2002/0171692).

It is well established that in respect of a novelty objection, the prior art must disclose all the integers of the invention as claimed. ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)).

Claim 1 has been amended to recite the novel feature of capturing data regarding customer requirements including a selected width and enabling the franchisee to print a roll of wallpaper, onto a web of black media and to slit the web of the wallpaper to the selected width. This features is not shown or suggested anywhere in Martin and was previously set out in claim 2 that was not objected to by the Examiner under 35 USC § 102. In the light of the amendment to claim 1 it is believed that the novelty objection is overcome and it is respectfully requested that the 35 USC § 102 (e) rejection based on Martin be withdrawn.

It is submitted that Claims 4,12,14,17,18,20,22,33,39,40-43,46,47,49 and 51 being dependent on a novel base claim, claim 1, are also novel and it is respectfully requested that the rejection of those claims as lacking novelty over Martin be withdrawn.

III Claim rejections 35 USC § 103

With regard to the obviousness objection under 35 USC § 103 (a) to claim 2, 3 and 11 based on Martin in view Fujii et al (US Patent No. 6715423) and Kwasny (US Patent Application No. 2002/01189900) we set out the following.

Martin does not disclose the newly added feature of claim 1 (previously contained in the now cancelled claim, claim 2) of capturing data regarding customer requirements including a selected width and enabling the franchisee to print a roll of wallpaper, onto a web of black media and to slit the web of the wallpaper to the selected width. Martin discloses printing wallpaper borders which are generally of a standard width. Martin does not disclose or suggest any ability to print to various widths or any another mechanism that will allow various width wallpaper borders to be produced. It would not be obvious to a

person skilled in the art to attempt to alter the invention disclosed by Martin to also print varying width borders. Martin only discloses printing borders and there is not disclosure or suggestion that the invention could be used to print larger wallpaper sheets.

Fugii et al. does not disclose or suggest the capturing customer data requirements comprising a customer selected width. As can be seen of Fig. 3E the customer enters an output size in terms of the size of the wall that needs to be covered and other additional detail. As can be seen from Figs. 9 and 10, once the customer has entered the output size and features of the wall that must be covered, the software works to calculate how best to print the wall paper to varying widths in order to achieve this. In Fugii et al the customer does not select the paper width. The selecting of a paper width is specific to the setting of the current invention which is the placement of an on-demand wallpaper printer with a franchise. As this on-demand printer is then designed to be suitable for direct customer use it is unsuitable to allow this device to determine what the best configuration for printing is. The customer is given only two options as to size - width and length of the actual wall paper (as opposed to the output size). The simplicity is necessary to enable a customer to be able to directly use the on-demand wallpaper printer.

Kwasny et al discloses slitting of a web in order to help ensure minimal paper loss. The slitting of the web of the current invention is not to ensure minimal paper loss but to enable the on-demand printer to print wall paper to the customer's selected requirements. By slitting the web using the current invention, one portion of the web is now wasted. Further Kwansy et al does not disclose or suggest that the slitting of the web is performed in accordance with a width measurement as selected by the customer.

We respectfully submit that a person skilled in the art would not have combined Martin with Fujii et al as Fujii et al's complex system of determining for the customer the complex requirements of printing a wallpaper design is not suitable for the franchise on-demand printer of the current invention which requires simplicity for use. Further, the person skilled in the art would not have combined Kwansy with either Martin or Fugii et al as Kwansy teaches the minimisation of paper waste which is not the aim of the current invention.

Accordingly we respectfully submit that claim 1 having the new and inventive feature of capturing data regarding customer requirements including a selected width and enabling the franchisee to print a roll of wallpaper, onto a web of black media and to slit the web of the wallpaper to the selected width is now allowable.

Further, it is also submitted that Claims 3 to 51 being dependent on an inventive base claim, claim 1, are also inventive and it is respectfully requested that the rejection of those claims as lacking inventiveness over Martin in view of Fujii et al and Kwansy be withdrawn.

Applicant has fully responded to each matter of substance raised in the Office Action and believes that the case is in condition for allowance. Withdrawal of the rejections and allowance of the application is therefore courteously solicited. Should the Examiner have any requests, questions or suggestions, the Examiner is invited to contact the Applicant at the number listed below.

Very respectfully,

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